

REMARKS

Claims 1-19 remain pending in the application.

The Applicants respectfully request the Examiner to reconsider earlier rejections in light of the following remarks. No new issues are raised nor is further search required as a result of the changes made herein. Entry of the Amendment is respectfully requested.

Claims 1, 2, 9, 10 and 15 over Chamberlin in view of Villa-Real

In the Office Action, claims 1, 2, 9, 10 and 15 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Chamberlin et al., U.S. Patent No. 4,817,127 ("Chamberlin") in view of Villa-Real, U.S. Patent No. 4,481,381 ("Villa-Real"). The Applicants respectfully traverse the rejection.

Claims 1, 2 and 9 recite, *inter alia*, an apparatus allowing a far end user to **simultaneously** hear a microphone signal and a user recorded message playback signal **while allowing a record module to simultaneously record** a voice of the far end user and the microphone signal of a speakerphone. Claims 10 and 15 recite, *inter alia*, a method of transmitting a combined microphone signal and playback signal that is able to be **simultaneously** performed with recording a microphone signal and a voice of a far end user.

The Office Action alleges that Chamberlin's playback module is a tape recorder and that the tape recorder plays a pre-recorded outgoing message to a far end user (Office Action, page 12). Moreover, the Examiner alleges that it is inherent that the outgoing message and the advisory message is recorded by a user (Office Action, page 12).

Under the doctrine of necessary inherency, anticipation may be established when a **single** prior art reference fails to disclose the claimed invention ipsisssimis verbis, but the natural and invariable practice of the reference would necessarily inherently meet all the elements of the claim. See, e.g., Verdegaaal Bros., Inc. v. Union Oil Col. of Cal., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 245 (Fed. Cir. 1985); Ethyl Molded Products Co. v. Betts Package Inc., No. 85-111

1032 (D.C.E.D. Kent. 1988). The doctrine of inherency is available only when the inherency can be established as a certainty; probabilities are not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); In re Chandler, 254 F.2d 396, 117 USPQ 361 (CCPA 1981); Ethyl Molded Prod. Co. at 1032.

As evidence of an alleged inherency, the Examiner interprets Chamberlin as being capable of playing a pre-recorded outgoing message and advisory message to a far end user, citing col. 16, lines 58-64 and col. 21 lines 27-36. These particular passages of Chamberlin disclose one recording/playback module is used to record an incoming telephone call while a second recording/playback module is used to transmit an outgoing message as done in an automatic telephone answering machine.

As the Examiner acknowledges, Chamberlin fails to disclose an outgoing message and an advisory message that are recorded by a user. The Examiner has inappropriately applied inherency in a §103(a) rejection. The Applicants respectfully request the improperly based rejection be withdrawn.

Chamberlin discloses two independent modules that separately connect to two distinct phone lines. A speakerphone module interacts with a first playback/record module connected to a first phone line used to record an incoming telephone call. A distinct second record/playback module connected to a second phone line is used to transmit an outgoing message, as is done in an automatic telephone answering machine (col. 16, lines 58-64). The first recording/playback module functions as a recorder of an incoming message while the second record/playback module functions to play back a prerecorded outgoing announcement message transmitted to another telephone (Chamberlin, col. 21, lines 27-36).

Therefore, on a given telephone line Chamberlin performs either a play function or a record function for different users, with only the record function connected to a speakerphone module. Chamberlin fails to disclose or suggest an apparatus and method that is able to records two voice signals while simultaneously transmitting a playback signal, i.e., a voice of a far end user and

a microphone signal while **simultaneously** transmitting a combined microphone signal and a playback signal, as recited by claims 1, 2, 9, 10 and 15.

Moreover, the piecemeal application of Chamberlin is improper: the reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention (see MPEP 2141.02 at page 2100-95 (Rev. 1, Feb. 2000) (citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 22 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984))). Chamberlin teaches away from performing **multiple actions** for any particular user on a telephone line by disclosing that the recording/playback modules perform separate functions on separate telephone lines for separate users.

“Teachings of references can be combined only if there is some suggestion or incentive to do so.” In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). Chamberline uses two record/playback modules on **separate telephone lines**. Neither Chamberlin nor Villa-Real provide any motivation to modify Chamberline’s invention to record two voice signals while allowing **simultaneous** transmission of a playback signal, i.e., a voice of a far end user and a microphone signal while allowing **simultaneous** transmission of a combined microphone signal and a playback signal, as recited by claims 1, 2, 9, 10 and 15.

The Office Action correctly acknowledged that Chamberlin fails to disclose recording a microphone signal while a microphone signal is combined with a message playback for transmitting to a far end user (Office Action, page 3). The Office Action relies on Villa-Real to allegedly make up for the deficiencies in Chamberlin to arrive at the claimed invention. The Applicants respectfully disagree.

The Office Action alleges that Villa-Real discloses a message that is a pre-recorded voice message (Office Action, page 12).

Villa-Real discloses use of a synthesized voice or speech message (see col. 13, lines 6-18), **NOT** disclosed as being recorded by a **user**. In fact, since the message is simply an announcement that the phone conversation is being recorded, with the same message given every time a phone conversation

is being recorded, there would be no purpose for having a user record such an announcement. Moreover, allowing a user to record such a message would allow for a user to record a message that does not inform a party to the conversation that the conversation is being recorded, completely mooting the purpose of such a feature.

Moreover, even if Villa-Real disclosed that the announcement message is a message that is recorded by a user (which Villa-Real does not), such a user recorded voice message is played for users using a conventional telephone, **NOT** a speakerphone, since Villa-Real fails to even mention a speakerphone. Applying the disclosure of Villa-Real to Chamberlin would at best **only allow** the users to hear the user recorded announcement message while Chamberlin is being used as a conventional telephone, **NOT** when used as a speakerphone, as recited by claims 1, 2, 9, 10 and 15.

Moreover, Villa-Real discloses a cordless musical extension telephone unit is capable of recording telephone conversations between calling parties, and in conjunction with this function, a synthesized intelligible voice is automatically announced informing the parties that the phone conversation is being recorded (see col. 2, lines 19-28; col. 12, line 57-col. 13, line 18). Villa-Real fails to disclose or suggest apparatus and method that records two voice signals while allowing **simultaneous** transmission of a playback signal, i.e., a voice of a far end user and a microphone signal while allowing **simultaneous** transmission of a combined microphone signal and a playback signal, as recited by claims 1, 2, 9, 10 and 15.

Neither Chamberlin nor Villa-Real, either alone or in combination, disclose, teach or suggest disclose or suggest apparatus and method that records two voice signals while allowing **simultaneous** transmission of a playback signal, i.e., a voice of a far end user and a microphone signal while allowing **simultaneous** transmission of a combined microphone signal and a playback signal, as recited by claims 1, 2, 9, 10 and 15.

Accordingly, for at least all the above reasons, claims 1, 2, 9, 10 and 15 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 3-5, 11-13 and 16-18 over Chamberlin in view of Villa-Real and Li

In the Office Action, claims 3-5, 11-13 and 16-18 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Chamberlin in view of Villa-Real, and further in view of Li, U.S. Patent No. 5,612,996 (“Li”). The Applicants respectfully traverse the rejection.

The Applicant respectfully suggest that the need to combine as many as three (3) separate patents to allegedly arrive at the presently claimed invention is evidence of the non-obviousness of the present invention.

Claims 3-5, 11-13 and 16-18 are dependent on claims 1, 10 and 15 respectively, and are allowable for at least the same reasons as claims 1, 10 and 15.

Claims 3-5 recite, *inter alia*, an apparatus allowing a far end user to simultaneously hear a microphone signal and a user recorded message playback signal while allowing a record module to simultaneously record a voice of the far end user and the microphone signal of a speakerphone. Claims 11-13 and 16-18 recite, *inter alia*, a method of transmitting a combined microphone signal and playback signal that is able to be simultaneously performed with recording a microphone signal and a voice of a far end user.

As discussed above, neither Chamberlin nor Villa-Real, either alone or in combination, disclose, teach or suggest a method and apparatus that records two voice signals while simultaneously transmitting a playback signal, i.e., a voice of a far end user and a microphone signal while allowing simultaneous transmission of a combined microphone signal and a playback signal, as recited by claims 1, 2, 9, 10 and 15.

The Office Action relies on Li to allegedly make up for the deficiencies in Chamberlin and Villa-Real to arrive at the claimed invention. The Applicants respectfully disagree.

Li appears to disclose a loop gain processing scheme for a speakerphone (Abstract). A system loop gain is determined according to two echo feedback paths within the speakerphone system (Li, Abstract). Li teaches the prior art had used a gain module comprised of an automatic gain control in

conjunction with a receive channel gain adjustment (Li, Fig. 1; col. 3, lines 44-52).

Li discloses gain control for a speakerphone. Li fails to disclose any type of record module, much less disclose or suggest an apparatus and method that records two voice signals while allowing simultaneous transmission of a playback signal, i.e., a voice of a far end user and a microphone signal while allowing simultaneous transmission of a combined microphone signal and a playback signal, as recited by claims 3-5, 11-13 and 16-18.

Neither Chamberlin, Villa-Real nor Li, either alone or in combination, disclose, teach or suggest an apparatus and method that records two voice signals while allowing simultaneous transmission of a playback signal, i.e., a voice of a far end user and a microphone signal while allowing simultaneous transmission of a combined microphone signal and a playback signal, as recited by claims 3-5, 11-13 and 16-18.

Accordingly, for at least all the above reasons, claims 3-5, 11-13 and 16-18 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 6-8, 14 and 19 over Chamberlin in view of Villa-Real, Li and Sacca

In the Office Action, claims 6, 7, 14 and 19 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Chamberlin in view of Villa-Real and Li, and further in view of Sacca, U.S. Patent No. 5,692,042 ("Sacca"), with claim 8 rejected under 35 U.S.C. §103(a) as allegedly being obvious over Chamberlin in view of Villa-Real, and further in view of Sacca. The Applicants respectfully traverse the rejection.

The Applicants respectfully suggest that the need to combine as many as four (4) separate patents to allegedly arrive at the presently claimed invention is evidence of the non-obviousness of the present invention.

Claims 6-8, 14 and 19 are dependent on claims 1, 10 and 15 respectively, and are allowable for at least the same reasons as claims 1, 10 and 15.

Claims 6-8 recite, *inter alia*, an apparatus allowing a far end user to simultaneously hear a microphone signal and a user recorded message playback signal while allowing a record module to simultaneously record a voice of the far end user and the microphone signal of a speakerphone. Claims 14 and 19 recite, *inter alia*, a method of transmitting a combined microphone signal and playback signal that is able to be simultaneously performed with recording a microphone signal and a voice of a far end user.

As discussed above, neither Chamberlin, Villa-Real nor Li disclose or suggest an apparatus and method that records two voice signals while allowing simultaneously transmission of a playback signal, i.e., a voice of a far end user and a microphone signal while allowing simultaneous transmission of a combined microphone signal and a playback signal, as recited by claims 6-8, 14 and 19.

The Office Action relies on Sacca to allegedly make up for the deficiencies in Chamberlin, Villa-Real and Li to arrive at the claimed invention. The Applicants respectfully disagree.

Sacca appears to disclose a speakerphone which employs non-linear amplifiers to compress transmit and receive signal (Abstract). Level detectors determine levels of the compressed transmit and receive signal (Sacca, Abstract). Selector switches permit the connection of a combined source signal and a signal from a handset microphone for transmission to a telephone line (Sacca, col. 8, lines 39-43). The combined source signal carries one or more alternate signal sources, e.g., tape playback, tones, synthesized speech, etc. for transmission over the telephone line (Sacca, col. 8, lines 43-49).

Sacca discloses a combined source signal comprising one or more alternate signal sources, e.g., tape playback, tones, synthesized speech, etc. for transmission over the telephone line. Sacca fails to disclose or suggest an apparatus and method that records two voice signals while allowing simultaneous transmission of a playback signal, i.e., a voice of a far end user and a microphone signal while allowing simultaneous transmission of a combined microphone signal and a playback signal, as recited by claims 6-8, 14 and 19.

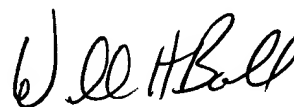
Neither Chamberlin, Villa-Real, Li nor Sacca, either alone or in combination, disclose, teach or suggest an apparatus and method that records two voice signals while allowing simultaneous transmission of a playback signal, i.e., a voice of a far end user and a microphone signal while allowing simultaneous transmission of a combined microphone signal and a playback signal, as recited by claims 6-8, 14 and 19.

Accordingly, for at least all the above reasons, claims 6-8, 14 and 19 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



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